

The second rejection of claim 16 also concerned the specification not reasonably providing enablement for a first element and a second element defining between them a space that is wider at the top than at the bottom or which progressively narrows from the top to the bottom wherein the first element has an actuating body fitted with a compressible element. Applicants have amended the specification to clarify that the space between the first and second holding elements is wider at the top than at the bottom. Support for this amendment is found on page 9, lines 8-11 of the specification, which states that a space is formed between the plate 31 and the front section 32, that corresponds to the space 13 between the first and second holding means 1 and 2 disclosed in Figs. 1-4.

The rejection of claim 17, concerned the specification not reasonably providing enablement for a first, second, third and fourth holding element with the first element having a protruding section and the first and second holding elements overlapping, each other. Applicants have rewritten claim 17 as new claim 21 to clarify the features of the device for holding several paper sheets. Support for this amendment is found on page 12 lines 6-20 of the specification.

Claims 13-20 were rejected under 35 U.S.C. § 112, second paragraph for being indefinite. The rejection of claims 13-20 concerned the phrase "as seen in the lateral projection." Applicants have amended claims 13, 16 and 19 to delete the phrase "as seen in the lateral projection" and place the claims in compliance with U.S. Patent Practice. Claims 14 and 15 depend from claim 13 and claims 18, 20 and new claim 21 depend from claim 19.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiromori (U.S. Patent No. 5,667,183) in view of Suzuki (U.S. Patent No. 5,845,889). Hiromori was cited for allegedly disclosing many elements of the claimed device. The Office Action acknowledged the Hiromori fails to disclose a second holding element having a protruding section. Accordingly, the Office Action applied Suzuki for disclosing a second holding element having a protruding section.

Claims 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fukuta (Japanese Patent No. 63-23169, hereinafter "JP '169"). Claims 18, 20 and 21 depend from claim 19.

Claims 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Egan (U.S. Patent No. 1,768,675). Egan was cited for allegedly disclosing many elements of claim 19. The Office Action alleged that since the specification and the species directed to Figs. 13 and 14 did not show a protruding section, that Egan disclosed the invention. Claims 18, 20 and 21 depend from claim 19.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over newly cited Berman (U.S. Patent No. 5,857,654) in view of Liptak (U.S. Patent No. 4,125,243). Berman was cited for allegedly disclosing many elements of the claimed device. The Office Action acknowledged that Berman fails to disclose the space being wider at the top than at the base. Accordingly, Liptak was applied for teaching a sign holder having a space being wider at the top than at the base. Claims 14 and 15 depend from claim 13.

Claim 13 of the present invention recites a device for holding a paper sheet in order to facilitate the viewing thereof. The device comprises a first holding element

having two bearing zones, and a second holding element having a protruding section, the first and second holding elements defining between them a space having a top and a base. The space opening upwards for accommodating the paper sheet to be inserted between the first and second holding elements, with the top of the space wider than the base of the space. The space progressively narrows from the top to the base, with a greater gradient near the top relative to near the base of the space. The first and second holding elements are arranged such that the protruding section and the bearing zones overlap each other partially to enable a curvature to be conferred gradually upon the paper sheet to be inserted. The protruding section and the bearing zones are tilted backwards with the protruding section tilted less than the bearing zones. Also, two lines of force are allowed to be created, on the paper sheet to be inserted, towards the upper angles of the paper sheet in order to rigidify the paper sheet. In addition, the device allows the paper sheet to be inserted to obtain a backward tilt ranging from 45° to 85°. The first holding element comprises a recess between the bearing zones.

Claim 16 of the present invention recites a device for holding a paper sheet in order to facilitate the viewing thereof. The device comprises a first holding element having two bearing zones, and a second holding element having a protruding section, the first and second holding elements defining between them a space having a top and a base. The space opening upwards for accommodating the paper sheet to be inserted between the first and second holding elements, with the top of the space wider than the base of the space. The space progressively narrows from the top to the base, with a greater gradient near the top relative to near the base of the space. The first and second holding elements are arranged such that the protruding section and the bearing

zones overlap each other partially to enable a curvature to be conferred gradually upon the paper sheet to be inserted. The protruding section and the bearing zones are tilted backwards with the protruding section tilted less than the bearing zones. Also two lines of force are allowed to be created, on the paper sheet to be inserted, towards the upper angles of the paper sheet in order to rigidify the paper sheet. In addition, the device allows the paper sheet to be inserted to obtain a backward tilt ranging from 45° to 85°. The first holding element is mounted on an articulation interconnected to an actuating body fitted with a compressible element in position against the second holding element, wherein actuation of the actuating body enables the first holding element to be spread apart from the second holding element in order to facilitate the placement of the paper sheet to be inserted.

Claim 19 of the present invention recites a device for holding a paper sheet in order to facilitate the viewing thereof. The device comprises a first holding element having two bearing zones, and a second holding element having a protruding section, the first and second holding elements defining between them a space having a top and a base. The space opening upwards for accommodating the paper sheet to be inserted between the first and second holding elements, with the top of the space wider than the base of the space. The space progressively narrows from the top to the base, with a greater gradient near the top relative to near the base of the space. The first and second holding elements are arranged such that the protruding section and the bearing zones overlap each other partially to enable a curvature to be conferred gradually upon the paper sheet to be inserted. The protruding section and the bearing zones are tilted backwards with the protruding section tilted less than the bearing zones. Also, two lines

of force are allowed to be created, on the paper sheet to be inserted, towards the upper angles of the paper sheet in order to rigidify the paper sheet. In addition, the device allows the paper sheet to be inserted to obtain a backward tilt ranging from 45° to 85°. Each of the bearing zones of the first holding element independently comprises a plane surface. An obtuse angle is defined between the plane surfaces at the base of the space having an apex directed towards the back of the device, the obtuse angle being from 90° to 160°.

An advantage of the present invention is that a paper sheet can be securely held while inclined for easy reading. The present invention is small, freestanding, and readily mobile so that it can be used on the planar surface, such as a work surface, without occupying much space or requiring extra parts for its positioning. Applicants submit that the prior art of Berman, Liptak, Hiromori, Suzuki, Egan and JP '169 fails to disclose or suggest the claimed invention.

JP '169 discloses a paper stand S1, including a disk base 1 and a hemisphere projecting block 2 integrally formed with the base. See Figs. 1-6. The block is divided into two parts. Between the two parts, a ridge 3 is formed to hold a number of papers P to be observed. One part of the block 2 is formed as a support block which supports the lower part of the papers P in a backwards inclined manner. The other part of the block is formed as a hang block 5 to press the lower part of the papers P and prevent them from curling. The ridge 3 is in a backwards inclined form and has a concave surface on the support block 4. The curvature of the ridge increases as it gets closer to the base 1. The inlet 8 of the ridge 3 is wide so that the papers P are easily inserted.

Applicants respectfully submit that JP '169 fails to disclose the features of the invention as recited in claim 19. Claim 19 recites a first holding member having two bearing zones. Each of the bearing zones of the first holding element independently comprises a plane surface. In contrast, JP '169 discloses a concave surface on the support block 4 and an apparent convex surface on the hang block 5. Therefore, it appears that JP '169 does not have a first holding element having two bearing zones. Rather, JP '169 discloses a continuous curve. Furthermore, the concave surface on the support block 4 in JP '169 does not appear to be a plane surface. Thus, it appears that JP '169 does not have a first holding element independently comprising a plane surface. As such, JP '169 fails to disclose the features of the invention as recited in claim 19.

According to the Manual of Patent Examining Procedure ("MPEP") §2131, a reference must teach every element of the claim in order to properly anticipate a claim. In addition, the Federal Circuit ruled, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. vs. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit Court also stated in a separate decision that "[t]he identical invention must be shown in a complete detail as is contained in the... claim" for the reference to anticipate the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

As such, Applicants respectfully submit that the rejection is improper since JP '169 does not teach, suggest, or disclose a first holding element having two bearing

zones or a first holding element independently comprising a plane surface as recited in presently pending claim 19 of this application. Accordingly, JP '169 does not anticipate claim 19, nor is claim 19 obvious in view of JP '169.

As mentioned above, claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiromori in view of Suzuki.

Hiromori discloses a convex holding member 2 provided with a convex holding surface 10a at the front end of the member 2. A leg portion 6 extends from a lower end portion of the member 2 in a direction of almost a right angle. A concave holding member 3 is provided with a concave holding surface 10b at the front end of the concave member 3 having a configuration in conformity with the holding surface 10a of the holding concave member 2. The concave member 3 and convex member 2 are arranged to form a holding part 10 by putting the holding surfaces 10a and 10b together. By pushing down on an operating portion 7 in the vicinity of the end of the concave holding member 3 the holding surface 10b of the concave holding member 3 separates from the holding surface 10a of the convex holding member 2 so as to open the holding part 10. Both sides of the concave holding member 3 are connected pivotably free upon at least one axis 5. A coil spring 4 has an elastic body disposed between the convex 2 and concave 3 holding members so as to press the holding surfaces 10a and 10b together due to the bias of the elastic body. The holding part 10 is formed in a manner such that the concave holding surface in the frontward direction is inclined at an angle of α in the backward direction.

Although the Office Action acknowledged that Hiromori fails to disclose the protruding section of the second holding element, Applicants respectfully submit that

Hiromori also fails to disclose other claimed features of the invention. Claim 16 recites a first holding element with two bearing zones. In contrast, Hiromori discloses a concave holding member 3 that has a single continuously curved zone. See Fig. 2. Claim 16 also recites that the protruding section is tilted backwards less than the bearing zones. Hiromori discloses that the holding surfaces 10a and 10b are pressed together and that they both are inclined at an angle of α in the backward direction. Since the surfaces 10a and 10b are pressed together and inclined, it stands to reason that any protruding section would also be tilted in the same angle α . Therefore, not only does Hiromori fail to disclose a second element having a protruding section, Hiromori also fails to disclose that even if the second element had a protruding section that it would be tilted backwards any less than the single zone continuously curved zone of concave holding member 3.

As mentioned above, Hiromori fails to disclose a protruding section of the second holding element. Suzuki was cited for teaching a protruding section on a second holding element. Suzuki was issued on December 8, 1998, and is based upon U.S. Patent Application Serial No. 08/919,004. The application was filed on August 27, 1997 and claims priority to a Japanese Application filed July 9, 1997. The present application although not filed until February 25, 1999, has an effective PCT filing date of April 24, 1997 (PCT/FR/97/00740), and claims priority from French Application No. 96 05218, filed April 25, 1996. Applicants direct the Examiner's attention to the April 26, 1996 priority filing date, the April 24, 1997 PCT filing date as well as the attached verified translation of the PCT priority document. Both priority dates of the present application are earlier than the filing date of Suzuki. Under PCT Article 11 and 35

U.S.C. §363, Suzuki is not, therefore, be a valid reference against this application under 35 U.S.C. §102 or §103. Therefore, as claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hiromori in view of Suzuki, as Suzuki as an improper reference, the obviousness rejection of claim 16 should be withdrawn.

As mentioned above, claims 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Egan (U.S. Patent No. 1,768,675).

Egan discloses a display device consisting of a base portion 37 of substantially rectangular form with upwardly converging integral wings 38 and 39 having their free edges terminating close to one another but spaced sufficiently apart to receive a card or other article which may be desired to insert therein. The wings are provided with a number of cross slots, a central cross slot 41, and lateral cross slots 42 and 43 in the wings. These slots are shown as extending in pairs in the same direction as the wings and may be arranged upright or at any inclination. The central slot 41 is substantially vertical, while the slots 42 and 43 converge upwardly to hold cards at substantially the same inclination on reversing the position of the holder.

Although claim 19 is rejected as obvious over Egan, the Office Action did not present any obvious features of Egan. Nevertheless, Applicants respectfully submit that fails to disclose the features of the invention. Claim 19 recites a second holding element having a protruding section. Egan does not disclose a protruding section. In addition, Egan fails to provide any motivation or suggestion to modify the display device and provide a protrusion to yield the claimed invention. Furthermore, Egan fails to disclose bearing - zones that overlap each other partially to enable a curvature to be conferred gradually upon the paper sheet to be inserted.

For a rejection under 35 U.S.C. §103, MPEP §706.02(j) requires the Patent Office to establish a *prima facie* case of obviousness using three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to have combined the referenced teaching. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success are to be found in the prior art and not based on Applicant's disclosure.

Accordingly, Applicants respectfully submit that Egan is completely deficient in the features recited in claim 19 and as such, does not provide a grounds for an obvious rejection under 35 U.S.C. § 103(a). As new claim 21 is dependent from claim 19, Egan also fails to disclose the features of new claim 21.

As mentioned above, claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Berman in view of Liptak.

Berman was issued on January 12, 1999, and is based upon U.S. Patent Application Serial No. 08/781,348. The application was filed on January 21, 1997. The present application, although not filed in the United States until February 25, 1999, has an effective PCT filing date of April 24, 1997, and claims priority from French Application No. 96 05218, filed April 25, 1996. This filing date is effective as the Applicants filed a certified copy of the French application with the PCT Application (PCT/FR/97/00740). Applicants direct the Examiner's attention to the April 25, 1996 priority filing date. In addition, Applicants direct the Examiner's attention to a copy of

the verified translation of the PCT priority document attached to this Response. Therefore, under PCT rules, the effective U.S. filing date of the present application should be the French Application date of April 25, 1996, which predates the filing date of Berman. Under PCT Article 11 and 35 U.S.C. § 363, Berman is not, therefore, be a valid reference against this application under 35 U.S.C. § 102 or § 103.

Applicants wish to thank the Examiner for indicating allowable subject matter in claims 15 and 20. As discussed above, claims 13 and 19 from which claims 15 and 20 respectively depend, have been amended to overcome the rejections under 35 U.S.C. §112. In that claims 15 and 20 were indicated as containing allowable subject matter, it is respectfully submitted that claims 15 and 20 are now in condition for allowance. Claims 15 and 20 were not placed in independent form as they depend from claims 13 and 19, respectively, which are allowable for the reasons submitted above.

Claims 13-16 and 18-21 are pending. Claims 14 and 15 depend from claim 13 and claims 18, 20 and 21 depend from claim 19. Applicant respectfully submits that these five dependent claims are allowable for their dependency from allowable base claims 13 and 19 as well as the additional subject matter recited therein. As discussed above, claims 18 and 19 were rejected under 35 U.S.C. §102 as being anticipated by JP '169. However, the reference fails to teach or suggest all of the features of the invention. Although claims 17 and 19 were rejected under 35 U.S.C. §103 as unpatentable over Egan, this reference also fails to disclose or suggest all of the features of the claimed invention. Claims 13 and 14 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Berman in view of Liptak. As discussed above, Applicants submit that Berman is not a proper reference under 35 U.S.C. §102 and

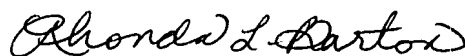
therefore cannot serve as a reference. Claim 16 was rejected under 35 U.S.C. §103(a) as unpatentable over Hiromori in view of Suzuki. Applicants also submit that Suzuki is not a proper reference under §102 and therefore also cannot serve as a reference. Therefore, Applicants respectfully requests either a new non-final Office Action or an allowance of claims 13, 14, 16, 18, 19 and 21, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300.

Respectfully submitted,

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Enclosures: Verified Translation of PCT/FR/97/00740
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Notification of Change of Name and Address

